REMARKS

I. PRELIMINARY REMARKS

Claims 1, 2, 18, 20, 24-26, 47, 51, 52 and 64 have been amended. Claim 65 has been added. Claims 22 and 55-63 have been canceled.[1] Claims 1-21, 23-26, 43-54, 64 and 65 remain in the application. Claims 3, 6-10, 12-16 have been withdrawn from consideration. Reexamination and reconsideration of the application, as amended, are respectfully requested.

Applicant notes that the Examiner has indicated that claim 46 would be allowable if rewritten in independent form.

II. PRIOR ART REJECTION

A. The Rejection

Claims 1, 2, 4, 5, 11, 17-26, 43-45 and 47-64 have been rejected under 35 U.S.C. § 102 as being anticipated by the Webster patent (U.S. Patent No. 5,431,168). As claims 22 and 55-63 have been canceled, applicant respectfully submits that the rejection thereof has been rendered moot. The rejection of the remaining claims under 35 U.S.C. § 102 is respectfully traversed with respect to the claims as amended above. Reconsideration thereof is respectfully requested.

B. The Webster Patent

The Webster patent is directed to a steerable open lumen catheter 10 that includes proximal catheter body 12 and a tip portion 14. The tip portion 14 includes ring

[1] The limitations of claim 22 have been added to independent claim 20. Additionally, applicant notes that the cancellation of claims 55-63 is not an acquiescence to the rejection under 35 U.S.C. § 102. Rather, claims 55-63 have been canceled because they were added in response to a rejection that has now been withdrawn.

electrodes 15 and a tip electrode 19, which is mounted by means of a tubular insert 21 that extends into a lumen 18 of the catheter 10. The catheter 10 also includes lumens 20 and 22. [Note Figure 2.] The puller wire 36 passes through the lumen 20 and is attached to the tip electrode 19 by a weld 31, while the lead wires 62 pass through lumen 22 and are connected to electrodes 15 and 19.

The Webster patent describes a number of configurations for the lumen 20. [Column 4, lines 10-67.] In one implementation, the lumen 20 includes a tightly wound coil spring 48 that extends though the lumen 20 in the proximal catheter body 12, but not into the tip portion 14, which instead includes a polytetrafluoroethylene (i.e. Teflon®) sleeve 38. The proximal and distal ends of the coil spring 48 are glued to the proximal catheter body 12. The puller wire 36 passes through the lumen defined by the coil spring 48 and the Teflon® sleeve 38. Alternatively, the Teflon® sleeve 38 may be eliminated and replaced by stretching a portion of the coil spring 48 so that a loosely wound distal portion 51 is located within the tip portion 14.[2] The tightly wound proximal portion 48 of the coil spring is attached to proximal and distal ends of the proximal catheter body 12. The Webster patent does not indicate whether or not the loosely wound distal portion 51 is secured to anything. The puller wire 36 passes through the lumen defined by the proximal portion 48 and the distal portion 51.

C. Claim Interpretation

Claims in an application are to be given their broadest reasonable interpretation. This interpretation must be "consistent with the specification" and "consistent with the one that those skilled in the art would reach." *In re Cortright*, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999).

[2] Although the text of the specification appears to state that there are two different springs 48 and 51, Figure 4 appears to show a single spring with two differently wound portions.

D. Discussion Concerning Claims 1, 4, 5, 11, 17-19 and 26

Independent claim 1 calls for a combination of elements comprising "an elongate body defining a proximal portion and a distal portion and ... the distal portion of the elongate body defining a proximal end and being more flexible than the proximal portion," "a steering wire," "a stiffening member secured to the distal portion of the elongate body, ***entirely located inward of the outer surface of the elongate body, and defining a proximal end that is substantially adjacent to the proximal end of the elongate body distal portion***" and "a handle." The combinations defined by claims 4, 5, 11, 17-19 and 26 include, *inter alia*, the elements recited in claim 1. The Webster patent fails to teach or suggest such combinations.

For example, with respect to independent claim 1, the Office Action appears to have taken the position that any one of the Webster ring electrodes 15, tubular insert 21 and spring distal portion 51 corresponds to the claimed "stiffening member." In contrast to the invention defined by claim 1, however, the outer surfaces of the Webster ring electrodes 15 are coextensive with the outer surface of the catheter 10, the proximal end of the Webster tubular insert 21 is not substantially adjacent to the proximal end of the tip portion 14, and there is nothing in the Webster patent which indicates that the spring distal portion 51 is secured to anything (other than the spring proximal portion 48).

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 1, applicant respectfully submits that claims 1, 4, 5, 11, 17-19 and 26 are patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

E. Discussion Concerning Claim 2

Independent claim 2 calls for a combination of elements comprising "an elongate body defining ... a central lumen," "a steering wire," "a stiffening member associated with the distal portion of the elongate body," "a stiffening member lumen offset from the

central lumen, at least a portion of the stiffening member being located within the stiffening member lumen ***and the steering wire not being located within the stiffening member lumen***" and "a handle." The Webster patent fails to teach or suggest such a combination.

For example, the Office Action appears to have taken the position that the Webster lumen 20 corresponds to the "stiffening member lumen." In contrast to the invention defined by claim 2, the Webster puller wire 36 is also located within the lumen 20.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 2, applicant respectfully submits that claim 2 is patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

F. Discussion Concerning Claims 20, 21 and 23

Independent claim 20 calls for a combination of elements comprising "an elongate body," "a steering wire," "a stiffening member," "***an anchoring member*** located within the wall of the distal portion of the elongate body between the inner surface and the outer surface and ***secured to the steering wire***" and "a handle." The combinations defined by claims 21 and 23 include, *inter alia*, the elements recited in claim 20. The Webster patent fails to teach or suggest such combinations.

For example, the Office Action appears to have taken the position that the Webster weld 31 corresponds to the claimed "anchoring member." This position is respectfully traversed. Although claim 20 does not limit the meaning of "anchoring member" to any particular type of "anchoring member," the claim interpretation presented in the Office Action is clearly inconsistent with present specification and with the Webster patent. The present specification describes an "anchoring member" as something to which a steering wire may be secured "by, for example, welding or adhesive." [Specification at page 10, lines 3-6.] Thus, there is no interpretation of the term "anchoring member" which is consistent with the specification that would read on a

weld. Turning to the Webster patent, it states that "[t]he distal end of the puller wire 36 is fixedly attached to the tip electrode 19, e.g., by weld 31 or the like." [Column 4, lines 61-62.] Much like the present specification, the Webster patent describes the weld 31 as being something that secures a steering wire to another structure (i.e. the tip electrode 19) that is actually anchoring the steering wire.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 20, applicant respectfully submits that claims 20, 21 and 23 are patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

G. Discussion Concerning Claims 24 and 43-45

Independent claim 24 calls for a combination of elements comprising, *inter alia*, "an anchoring member," "a stiffening member ... ***defining a distal end secured to the anchoring member***" and "an anti-tear device configured and positioned relative to the stiffening member so as to prevent the stiffening member from tearing through the elongate body when the stiffening member bends." The combinations defined by claims 43-45 include, *inter alia*, the elements recited in claim 24. The Webster patent fails to teach or suggest such combinations.

For example, the Office Action appears to have taken the position that with respect to independent claim 24, either one of the Webster tubular element 21 and spring distal portion 51 corresponds to the "stiffening member" and that the ring electrodes 15 and/or the sleeve 38 correspond to the "anti-tear device." Even assuming for the sake of argument that this is a reasonable interpretation of the claims,[3] claim 24 requires the distal end of the "stiffening member" to be secured to the "anchoring member." The only "anchoring member" identified in the Office Action is the Webster weld 31, and there is no indication that the distal end of the tubular element 21 or the distal end of the spring distal portion 51 is secured to the weld.

[3] Applicant respectfully submits that it is not.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 24, applicant respectfully submits that claims 24 and 43-45 are patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

H. Discussion Concerning Claim 25

Independent claim 25 calls for a combination of elements comprising, *inter alia*, "a steering wire," "an anchoring member associated with the distal portion of the elongate body and secured to the steering wire," "an anti-tear device" and "a ***stiffening member*** associated with the distal portion of the elongate body and defining a distal end secured to the anchoring member and a ***proximal end secured to the anti-tear device***." The Webster patent fails to teach or suggest such a combination.

For example, the Office Action appears to have taken the position that with respect to claim 25, the ring electrodes 15 and/or the sleeve 38 correspond to the "anti-tear device" and either one of the Webster tubular element 21 and spring distal portion 51 corresponds to the "stiffening member." [The Office Action also appears to indicated that the tip electrode 19 corresponds to something, but it is not entirely clear what that something is.] Even assuming for the sake of argument that this is a reasonable interpretation of the claims,[4] the proximal end of the tubular element 21 is not secured to the ring electrodes 15 or the sleeve 38, nor is the proximal end of the spring distal portion 51 secured to the ring electrodes 15 or the sleeve 38.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 25, applicant respectfully submits that claim 25 is patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

[4] Applicant respectfully submits that it is not.

I. Discussion Concerning Claims 47, 48, 50, 51, 53 and 54

Independent claim 47 calls for a combination of elements comprising, *inter alia*, "a stiffening member," "an anti-tear device positioned adjacent to at least a portion of the stiffening member and configured to prevent the stiffening member from tearing through the elongate body when the stiffening member bends" and "***a steering wire***, which is not connected to the anti-tear device and which is ***not located within the stiffening member***." The combinations recited in claims 48, 50, 51, 53 and 54 include, *inter alia*, the elements recited in claim 47. The Webster patent fails to teach or suggest such combinations.

For example, the Office Action appears to have taken the position that with respect to independent claim 47, the spring proximal and distal portions 48 and 51 correspond to the "stiffening member" and that the tubular element 21 and/or the glue 49 corresponds to the "anti-tear device." Even assuming for the sake of argument that this is a reasonable interpretation of the claims,[5] the Webster puller wire 36 is located within the spring proximal and distal portions 48 and 51.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 47, applicant respectfully submits that claims 47, 48, 50, 51, 53 and 54 are patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

J. Discussion Concerning Claim 49

Independent claim 49 calls for a combination of elements comprising, *inter alia*, "a stiffening member associated with the distal portion of the elongate body and defining a proximal end" and "an anti-tear device, defining a proximal end and a distal end, secured to the proximal end of the stiffening member such that the proximal end of the anti-tear device is located within the distal portion of the elongate body." The Webster patent fails to teach or suggest such a combination.

[5] Applicant respectfully submits that it is not.

For example, the Office Action appears to have taken the position that with respect to claim 49, the tip electrode 19 corresponds to the claimed "stiffening member" and that any one of the tubular insert 21, Teflon® sleeve 38 and spring distal portion 51 corresponds to the "anti-tear device." The fact that other portions of the Office Action refer to the tubular insert 21 and spring distal portion 51 as the "stiffening member" notwithstanding, there is no reasonable interpretation of the claim that would result in a tip electrode, which is mounted in the distal end of a catheter, corresponding to the claimed "stiffening member. There is also nothing in the Webster patent which indicates that the Teflon® sleeve 38 and spring distal portion 51 are secured to the tip electrode 19.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 49, applicant respectfully submits that claim 49 is patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

K. Discussion Concerning Claim 52

Independent claim 52 calls for a combination of elements comprising, *inter alia*, "a steering wire," "a stiffening member associated with the distal portion of the elongate body" and "a ***substantially c-shaped anti-tear device*** with a slot associated with the stiffening member." The Webster patent fails to teach or suggest such a combination.

For example, the Office Action appears to have taken the position that with respect to claim 52, the Teflon ® sleeve 38 in the Webster proximal catheter body 12 corresponds to the claimed anti-tear device. Even assuming for the sake of argument that this is a reasonable interpretation of the claims,[6] the Webster sleeve 38 is not substantially c-shaped.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 52, applicant respectfully submits that claim

[6] Applicant respectfully submits that it is not.

52 is patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

L. Discussion Concerning Claim 64

Independent claim 64 calls for a combination of elements comprising, *inter alia*, "a stiffening member associated with the distal portion of the elongate body such that the stiffening member will apply a force over an elongate body surface area when the stiffening member is bent" and "***anti-tear means***, associated with the stiffening member, ***for increasing the elongate body surface area over which the force is applied when the stiffening member is bent to prevent the stiffening member from tearing through the elongate body***." The Webster patent fails to teach or suggest such a combination.

For example, the Office Action appears to have taken the position that with respect to claim 64, the Webster Teflon® sleeve 38 corresponds to the "stiffening member" and that the ring electrodes 15 correspond to the "anti-tear means." Even assuming for the sake of argument that this is a reasonable interpretation of the claims,[7] the Webster ring electrodes 15 do not perform the function set forth in the means-plus-function element.

As the Webster patent fails to teach or suggest each and every element of the combination recited in independent claim 64, applicant respectfully submits that claim 64 is patentable thereover and that the rejection thereof under 35 U.S.C. § 102 should be withdrawn.

III. NEWLY PRESENTED CLAIM 65

Newly presented claim 65 depends from independent claim 49 and is patentable for at least the same reasons as claim 49.

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[7] Applicant respectfully submits that it is not.

IV. CLOSING REMARKS

In view of the foregoing, it is respectfully submitted that the claims in the application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are respectfully requested. Allowance of the claims at an early date is courteously solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is respectfully requested to call applicant's undersigned representative at (310) 563-1458 to discuss the steps necessary for placing the application in condition for allowance.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 50-0638. Should such fees be associated with an extension of time, applicant respectfully requests that this paper be considered a petition therefor.

Respectfully submitted,

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